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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,290	07/24/2001	Blake B. Boggett	7150	5201

7590 05/23/2003  
Robert D. Touslee  
Johns Manville Corporation  
10100 West Ute Avenue  
Littleton, CO 80127

EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/912,290

Applicant(s)

BOGRETT ET AL.

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to an insulation batt, classified in class 442, subclass 327.
  - II. Claims 10-18, drawn to a method of making an insulation batt, classified in class 28, subclass various.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case aligning the fibers parallel to the lateral surfaces of the batt may make the insulation batt without cutting an insulation blanket having the fibers parallel to the major surfaces.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert Touslee on May 19, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-9. Applicant must make affirmation of this election in replying to this Office

action. Claims 10-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "the fibers of the batt being randomly oriented and entangled together and predominately lying in planes that extend substantially perpendicular to the major surface and the end surfaces of the batt and substantially parallel to the lateral surfaces of the batt" in lines 9-12 of the claim. This is indefinite because it is impossible for fibers to be aligned perpendicular to two out of three dimensional planes. Fibers can only be oriented perpendicular to one plane at a time. If a fiber were perpendicular to the major surface, it would have to be parallel to both the end surface and lateral surface. According to the specification, the invention is understood to be a batt with all fibers being oriented parallel to the lateral surface, with some fibers that would be perpendicular to the major surface and some fibers that would be perpendicular to the end surface. However, no individual fiber can be perpendicular to both major surface and end surface, as the claim presently recites. Reading the claim on its face is confusing because it states that fibers are oriented perpendicular to both planes.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Michelsen (U.S. Patent No. 5,765,318).

Michelsen discloses a fibrous insulation material where the fibers lie in a parallel plane (Figure 3). The claims of the present application do not differentiate which planes of the batt define the major surfaces, lateral surfaces, or end surfaces (i.e. nothing indicates that the length must be greater than the width or the width must be greater than the thickness). Therefore, one may define the lateral surface of the batt of Michelsen as the surface that is parallel to the plane of the fibers. The insulation is compressible (column 3, line 62). With regard to claims 2, 5, and 8, the fibers may be glass (column 3, line 64). With regard to claims 3, 6, and 9, the fibers may be polymeric (column 3, line 65). With regard to claims 4 and 7, the fibers may be bonded with binder (column 3, line 66) or binderless (column 4, line 3).

9. Claims 1, 2, 4, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Houpt et al. (U.S. Patent No. 5,536,550).

Houpt et al. disclose an insulation batt with fibers that are parallel to the lateral surface (Figure 3). The fibers are glass (column 3, line 37) and the batt may have binder (column 3, line 13) or be binderless (column 3, lines 7-8).

10. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Fay (U.S. Patent No. 6,484,463).

Fay discloses an insulation batt with the fibers aligned parallel to the lateral direction (Figure 2). The fibers may be glass (column 3, line 22) or polymeric (column 3, line 29). The batt can use binder (column 3, line 31) or be binderless (column 3, line 34).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

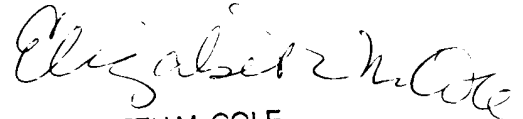
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeremy R. Pierce  
Examiner  
Art Unit 1771

May 19, 2003



ELIZABETH M. COLE  
PRIMARY EXAMINER